

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellants: Daniel Scheidewend et al.
Serial Number: 09/445,268
Atty. Docket: RCA 89,068
Filing Date: April 3, 2000
For: SYSTEM AND METHOD FOR COORDINATING USER ACTIONS
Art Unit: 2424
Examiner: Michael Van Handel

APPEAL BRIEF

**Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450**

Sir:

In response to the final Office Action dated April 28, 2009 and the Advisory Action dated July 20, 2009, and further to the Notice of Appeal filed on July 28, 2009, Appellants hereby submit an Appeal Brief in accordance with 37 C.F.R. §41.37 for the above-referenced application.

I. Real Party in Interest

The real party in interest is Thomson Licensing LLC.

II. Related Appeals and Interferences

There are no prior or pending appeals, interferences, or judicial proceedings known to Appellants, the Appellants' legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. Status of Claims

Claims 1-15 are cancelled. Claims 16-25 are rejected. The rejection of claims 16-25 is being appealed.

IV. Status of Amendments

No amendment subsequent to the final rejection of April 28, 2009 has been filed.

V. Summary of Claimed Subject Matter

Independent claim 16 defines a method for processing a plurality of programs using a video apparatus. The method comprises: receiving, via the video apparatus, a first user input selecting a first program for removal from a first list representing a list of programs scheduled for recording (page 29, lines 17-21; FIGS. 7 and 11); receiving, via the video apparatus, a second user input selecting a second program for removal from a second list representing a list of programs purchased (page 30, lines 8-19; FIGS. 8 and 12); determining, via the video apparatus, whether the second program also appears on the first list responsive to the second user input (page 30, lines 19-22; FIG. 8); and removing, automatically via the video apparatus, the second program from the first list if the second program appears on the first list (page 30, lines 22-24; FIG. 8).

Independent claim 17 defines a method for processing a program using a video apparatus. The comprises: removing, via the video apparatus and in response to a user command, the program from a first list of programs representing programs scheduled for recording (page 29, lines 17-21; FIGS. 7 and 11); determining, via the

video apparatus and in response to the user command, whether the program is also a purchased program (page 29, lines 22-25; FIG. 7); enabling, via the video apparatus, an on screen display including an option to cancel the purchase of the program if it is determined that the program is also a purchased program (page 29, line 25 to page 30, line 1; FIGS. 7 and 12); and removing, via the video apparatus, the program from a second list of programs representing purchased programs responsive to user selection of the option (page 30, lines 1-3; FIG. 7).

Independent claim 18 defines an apparatus for processing a program, comprising: first means (element 312; FIG. 4) for receiving a first user input selecting a first program for removal from a first list representing a list of programs scheduled for recording (page 29, lines 17-21; FIGS. 7 and 11), and for receiving a second user input selecting a second program for removal from a second list representing a list of programs purchased (page 30, lines 8-19; FIGS. 8 and 12); and second means (element 315; FIG. 4) for determining whether the second program also appears on the first list responsive to the second user input (page 30, lines 19-22; FIG. 8), and for automatically removing the second program from the first list if the second program appears on the first list (page 30, lines 22-24; FIG. 8).

Dependent claim 19 is dependent on claim 18, and states that the second means enables display of an on screen user option indicating that a user can both purchase and record a selected program so that the user does not have to select one of purchase and record user options and then select the other user option to purchase and record the selected program (page 18, lines 4-5; option 940).

Independent claim 20 defines an apparatus for processing a program, comprising: first means (element 312; FIG. 4) for receiving a user command; and second means (element 315; FIG. 4) for removing the program from a first list of programs representing programs scheduled for recording responsive to the user command (page 29, lines 17-21; FIGS. 7 and 11). The second means determines whether the program is also a purchased program responsive to the user command (page 29, lines 22-25; FIG. 7), and enables an on screen display including an option to

cancel the purchase of the program if it is determined that the program is also a purchased program (page 29, line 25 to page 30, line 1; FIGS. 7 and 12). The program is removed from a second list of programs representing purchased programs responsive to user selection of the option (page 30, lines 1-3; FIG. 7).

Dependent claim 21 is dependent on claim 20, and states that the second means enables display of an on screen user option indicating that a user can both purchase and record a selected program so that the user does not have to select one of purchase and record user options and then select the other user option to purchase and record the selected program (page 18, lines 4-5; option 940).

Independent claim 22 defines an apparatus for processing a program, comprising: a receiver (element 312; FIG. 4) operative to receive a first user input selecting a first program for removal from a first list representing a list of programs scheduled for recording (page 29, lines 17-21; FIGS. 7 and 11), and to receive a second user input selecting a second program for removal from a second list representing a list of programs purchased (page 30, lines 8-19; FIGS. 8 and 12); and a processor (element 315; FIG. 4) operative to determine whether the second program also appears on the first list responsive to the second user input (page 30, lines 19-22; FIG. 8), and to automatically remove the second program from the first list if the second program appears on the first list (page 30, lines 22-24; FIG. 8).

Dependent claim 23 is dependent on claim 22, and states that the processor enables display of an on screen user option indicating that a user can both purchase and record a selected program so that the user does not have to select one of purchase and record user options and then select the other user option to purchase and record the selected program (page 18, lines 4-5; option 940).

Independent claim 24 defines an apparatus for processing a program, comprising: a receiver (element 312; FIG. 4) operative to receive a user command; and a processor (element 315; FIG. 4) operative to remove the program from a first list of programs representing programs scheduled for recording responsive to the user

command (page 29, lines 17-21; FIGS. 7 and 11). The processor is further operative to determine whether the program is also a purchased program responsive to the user command (page 29, lines 22-25; FIG. 7), and to enable an on screen display including an option to cancel the purchase of the program if it is determined that the program is also a purchased program (page 29, line 25 to page 30, line 1; FIGS. 7 and 12). The program is removed from a second list of programs representing purchased programs responsive to user selection of the option (page 30, lines 1-3; FIG. 7).

Dependent claim 25 is dependent on claim 24, and states that the processor enables display of an on screen user option indicating that a user can both purchase and record a selected program so that the user does not have to select one of purchase and record user options and then select the other user option to purchase and record the selected program (page 18, lines 4-5; option 940).

VI. Grounds of Rejection to be Reviewed on Appeal

The following grounds of rejection are presented for review in this appeal:

A. The rejection of claims 16-18, 20, 22 and 24 under 35 U.S.C. §103(a) based on U.S. Patent No. 5,850,218 issued to LaJoie et al. (hereinafter, "LaJoie"); and

B. The rejection of claims 19, 21, 23 and 25 under 35 U.S.C. §103(a) based on LaJoie in view of the RCA DRD202RA Owner's Manual (hereinafter, "the RCA manual").

VII. Argument

A. Patentability of Claims 16-18, 20, 22 and 24

The rejection of claims 16-18, 20, 22 and 24 under 35 U.S.C. §103(a) based on LaJoie should be reversed for at least the following reasons.

At the outset, Appellants note that the claimed invention addresses and solves a general problem related to how to provide coordination between performing program purchases and program recordings. In particular, the claimed invention addresses two specific situations where coordination between performing program purchases and program recordings is needed.

The first situation occurs when a user selects a program for both purchase and recording, and **later** decides to cancel the purchase. The solution to the problem in this first situation is defined by independent claims 16, 18 and 22. In particular, independent claims 16, 18 and 22 define a method/apparatus in which a program (i.e., the “second program”) is automatically removed from a list of programs scheduled for recording (i.e., the “first list”) in response to user removal of the program from a list of programs selected for purchase (i.e., the “second list”).

The second situation occurs when a user selects a program for both purchase and recording, and **later** decides to cancel the recording. The solution to the problem in this second situation is defined by independent claims 17, 20 and 24. In particular, independent claims 17, 20 and 24 define a method/apparatus in which an on screen display option is provided so that a user is afforded an opportunity to cancel the purchase of a program in response to the user canceling a scheduled recording of the program.

On pages 5-6 of the final Office Action dated April 28, 2009, the Examiner admits that LaJoie fails to disclose all of the elements of independent claims 16-18, 20, 22 and 24. However, the Examiner alleges that a “conflict checking feature” of LaJoie serves as the basis for rendering claims 16-18, 20, 22 and 24 obvious under 35 U.S.C. §103(a). Appellants respectfully disagree.

First, Appellants note that the aforementioned “conflict checking feature” of LaJoie specifically addresses only a limited number of conflict situations. In particular, LaJoie describes this limited number of conflict situations as follows:

“Conflicts can arise, for example, when there are overlapping timers, unusual settings (such as VCR record timers which exceed typical tape length), record timers for unpurchased Impulse Pay-Per-View (IPPV) events, attempts to set up more than a limiting number of VCR timers (e.g., eight), and attempts to purchase more than a limiting number of IPPV events (e.g., eight).” (see column 21, lines 35-42)

As indicated above, LaJoie expressly describes only a limited number of conflict situations. Moreover, and most significantly, LaJoie fails to even recognize the two specific situations described above which are addressed by the claimed invention. That is, LaJoie fails to address the first situation where a user selects a program for both purchase and recording, and later decides to cancel the purchase. Moreover, LaJoie fails to address the second situation where a user selects a program for both purchase and recording, and later decides to cancel the recording. As such, LaJoie fails to recognize and address the two specific problems that are solved by the claimed invention.

Given that LaJoie fails to even recognize the two specific problems that are solved by the claimed invention, it's not surprising that the reference also fails to disclose or suggest the solutions defined by independent claims 16-18, 20, 22 and 24, or the desirability thereof. Here, Appellants again note that the mere fact that a prior art device could (in hindsight) be modified to produce a claimed invention is not a basis for an obviousness rejection unless the prior art suggests the desirability of such a modification. See, for example, *In re Laskowski*, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1989) ("Although the Commissioner suggests that [the structure in the primary prior art reference] could readily be modified to the form the [claimed] structure, '[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.'") and *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). In this case, Appellants maintain that LaJoie fails to teach or suggest the desirability of the solutions defined by independent claims 16-18, 20, 22 and 24.

Moreover, Appellants submit that there is no apparent reason that one of ordinary skill in the art would even attempt to modify the teachings of LaJoie in the manner proposed by the Examiner, see *KSR Int'l v. Teleflex, Inc.*, 127 S. Ct. 1727, 1740-41 (2007). This is particularly evidenced by the facts pointed out above in that LaJoie fails to even recognize the two specific situations, and their associated problems, which are addressed and solved by the claimed invention. That is, LaJoie fails to recognize a situation where a user selects a program for both purchase and

recording, and later decides to cancel the purchase, and also fails to recognize a situation where a user selects a program for both purchase and recording, and later decides to cancel the recording. As such, Appellants submit that the Examiner's application of the Graham factors is clearly the result of impermissible hindsight based on teachings gleaned only from the Appellants' disclosure, and from improperly filling-in the missing gaps of the prior art in an attempt to meet the elements of the claimed invention.

In the Advisory Action dated July 20, 2009, the Examiner responds to the foregoing arguments by stating:

"Regarding claims 16-18, 20, 22 and 24, the applicant argues that the examiner's application of the Graham factors is based on impermissible hindsight. The examiner respectfully disagrees. It must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971)" (emphasis added)

In response, Appellants submit that the Examiner's hindsight in the instant rejection does not take into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made. Rather, Appellants submit that the Examiner's hindsight clearly includes knowledge gleaned only from Appellants' disclosure. Again, Appellants' position is clearly supported by the fact that LaJoie fails to even recognize the two specific situations, and their associated problems, which are addressed and solved by the claimed invention. Moreover, the Examiner has failed to produce any prior art that does recognize these two specific situations, and their associated problems. As such, Appellants submit that the Examiner's hindsight is based on teachings gleaned only from the Appellants' disclosure.

Also in the Advisory Action dated July 20, 2009, the Examiner alleges:

“The examiner acknowledges Applicant’s argument that LaJoie et al. fails to even recognize the two specific situations described in the claims, and that LaJoie et al. fails to teach or suggest a desirability or apparent reason for such a modification. The examiner notes; however, that LaJoie et al. recognizes that there are situations in which conflicts will arise due to unusual settings caused by user selection, and that LaJoie et al. provides a way of resolving these conflicts. Despite not having explicitly stated every possible conflict that could arise, LaJoie et al. provides a way of resolving the conflicts that occur when unusual settings and conflicts occur in the coordination of multiple lists. As such... the examiner maintains that the claimed conflict resolution techniques would have been obvious given the teachings of LaJoie et al...” (emphasis added)

In response, Appellants again note that LaJoie discloses and addresses only a limited number of conflict situations (see column 21, lines 35-42), and fails to even recognize the two specific conflict situations which are addressed by the claimed invention. Clearly, the limited disclosure of LaJoie can not render every type of conflict resolution technique obvious, as the Examiner ostensibly suggests. Such a result is contrary to the spirit of the U.S. Patent Laws, and would surely stifle innovation and the progress of science and useful arts.

Accordingly, for at least the foregoing reasons, Appellants submit that claims 16-18, 20, 22 and 24 are patentable over LaJoie under 35 U.S.C. §103(a), and respectfully request that the Board reverse this rejection.

B. Patentability of Claims 19, 21, 23 and 25

The rejection of claims 19, 21, 23 and 25 under 35 U.S.C. §103(a) based on the proposed combination of LaJoie and the RCA manual should be reversed since the RCA manual is relied upon only for disclosing a “Buy and Record Option” and is unable to remedy the deficiencies of LaJoie pointed out above in conjunction with claims 16-18, 20, 22 and 24. Accordingly, Appellants respectfully request that the Board reverse the rejection of claims 19, 21, 23 and 25.

VIII. Claims Appendix

16. A method for processing a plurality of programs using a video apparatus, the method comprising:

receiving, via said video apparatus, a first user input selecting a first program for removal from a first list representing a list of programs scheduled for recording;

receiving, via said video apparatus, a second user input selecting a second program for removal from a second list representing a list of programs purchased;

determining, via said video apparatus, whether said second program also appears on said first list responsive to said second user input; and

removing, automatically via said video apparatus, said second program from said first list if said second program appears on said first list.

17. A method for processing a program using a video apparatus, the method comprising:

removing, via said video apparatus and in response to a user command, said program from a first list of programs representing programs scheduled for recording;

determining, via said video apparatus and in response to said user command, whether said program is also a purchased program;

enabling, via said video apparatus, an on screen display including an option to cancel the purchase of said program if it is determined that said program is also a purchased program; and

removing, via said video apparatus, said program from a second list of programs representing purchased programs responsive to user selection of said option.

18. An apparatus for processing a program, comprising:

first means for receiving a first user input selecting a first program for removal from a first list representing a list of programs scheduled for recording, and for receiving a second user input selecting a second program for removal from a second list representing a list of programs purchased; and

second means for determining whether said second program also appears on said first list responsive to said second user input, and for automatically removing said second program from said first list if said second program appears on said first list.

19. The apparatus of claim 18, wherein said second means enables display of an on screen user option indicating that a user can both purchase and record a selected program so that said user does not have to select one of purchase and record user options and then select the other user option to purchase and record said selected program.

20. An apparatus for processing a program, comprising:
first means for receiving a user command;
second means for removing said program from a first list of programs representing programs scheduled for recording responsive to said user command;
said second means determining whether said program is also a purchased program responsive to said user command, and enabling an on screen display including an option to cancel the purchase of said program if it is determined that said program is also a purchased program; and
wherein said program is removed from a second list of programs representing purchased programs responsive to user selection of said option.

21. The apparatus of claim 20, wherein said second means enables display of an on screen user option indicating that a user can both purchase and record a selected program so that said user does not have to select one of purchase and record user options and then select the other user option to purchase and record said selected program.

22. An apparatus for processing a program, comprising:
a receiver operative to receive a first user input selecting a first program for removal from a first list representing a list of programs scheduled for recording, and to receive a second user input selecting a second program for removal from a second list representing a list of programs purchased; and
a processor operative to determine whether said second program also appears on said first list responsive to said second user input, and to automatically remove said second program from said first list if said second program appears on said first list.

23. The apparatus of claim 22, wherein said processor enables display of an on screen user option indicating that a user can both purchase and record a selected program so that said user does not have to select one of purchase and record user options and then select the other user option to purchase and record said selected program.

24. An apparatus for processing a program, comprising:
a receiver operative to receive a user command;
a processor operative to remove said program from a first list of programs representing programs scheduled for recording responsive to said user command;
said processor being further operative to determine whether said program is also a purchased program responsive to said user command, and to enable an on screen display including an option to cancel the purchase of said program if it is determined that said program is also a purchased program; and
wherein said program is removed from a second list of programs representing purchased programs responsive to user selection of said option.

25. The apparatus of claim 24, wherein said processor enables display of an on screen user option indicating that a user can both purchase and record a selected program so that said user does not have to select one of purchase and record user options and then select the other user option to purchase and record said selected program.

IX. Evidence Appendix

None.

X. Related Proceedings Appendix

None.

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Respectfully submitted,
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